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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/820,852 | 03/30/2001 | Haruhiko Kishi | 205041US-6 | 7025 |

22850 7590 08/10/2005

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| EXAMINER |
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TRAN, ELLEN C

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| ART UNIT | PAPER NUMBER |
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2134

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,852

Applicant(s)

KISHI ET AL.

Examiner

Ellen C. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication: amendment filed 8 December 2004, with original application filed 30 March 2001, with acknowledgement of foreign application date or 30 March 2000.
2. Claims 1-20 are currently pending in this application. Claims 1, 10, 19, and 20 are independent claims. Claims 1, 2, 6, 8, 10, 11, 13, 15, 17, and 19 have been amended. Claim 20 is new.
3. Amendments to the claims and specification are accepted.

Response to Arguments

4. Applicant's arguments with respect to claims 1-20 have been considered but are not persuasive.

In response to applicant's argument on page 11, "Conversely, in the exemplary embodiment of the Applicant's invention, content is selected from a list of available content by a user via vending apparatus ... Downs does not disclose or suggest generating usage rules and an encryption key in response to a purchase selection". The Office disagrees content selection and distribution is shown in '618 col. 9, lines 4-47, in addition a more detailed description of the content packaging per user selection is shown in col. 48 line 27 through col. 50, line 33 "Content Provider(s) 101 or content proprietor(s) are owners of original Content 113 and/or distributors authorized to package independent Content 113 for further distribution. Content Provider(s) 101 may exploit their rights directly or license Content 113 to the Electronic Digital Content Store(s)

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103, or Intermediate Market Partners (not shown), usually in return for Content usage payments related to electronic commerce revenues. Examples of Content Provider(s) 101 include Sony, Time-Warner, MTV, IBM, Microsoft, Turner, Fox and others. Content Provider(s) 101 use tools provided as part of the Secure Digital Content Electronic Distribution System 100 in order to prepare their Content 113 and related data for distribution. A Work Flow Manager Tool 154 schedules Content 113 to be processed and tracks the Content 113 as it flows through the various steps of Content 113 preparation and packaging to maintain high quality assurance. The term metadata is used throughout this document to mean data related to the Content 113 and in this embodiment does not include the Content 113 itself. As an example, metadata for a song may be a song title or song credits but not the sound recording of the song. The Content 113 would contain the sound recording. A Metadata Assimilation and Entry Tool 161 is used to extract metadata from the Content Provider(s)' Database 160 (for a music example the Content 113 information such as CD title, artist name, song title, CD artwork, and more) and to package it for electronic distribution. The Metadata Assimilation and Entry Tool 161 is also used to enter the Usage Conditions for the Content 113. The data in Usage Conditions can include copy restriction rules, the wholesale price, and any business rules deemed necessary ... The encrypted Content 113, digital content-related data or metadata, and encrypted keys are packed in SCs (described below) by the SC Packer Tool and stored in a content hosting site and/or promotional web site for electronic distribution. The content hosting site can reside at the Content Provider(s) 101 or in multiple locations, including Electronic Digital Content Store(s) 103 and Intermediate Market Partners (not shown) facilities. Since both the Content 113 and the Keys (described below) are encrypted and packed in SCs, Electronic Digital Content Store(s) 103 or any other

hosting agent can not directly access decrypted Content 113 without clearance from the Clearinghouse(s) and notification to the Content Provider(s) 101". The content for distribution packaged in a SC are placed on a Database and distributed by content providers.

In response to applicant's argument on page 11 "Likewise, Downs does not disclose or suggest providing the usage rules, encryption key and content to a recording medium authenticated by the vending apparatus as rejected in Claim or any depending therefrom by virtue of dependency". The Office disagrees this limitation is clearly shown in '618 col. 7, lines 11-55 "Licensing authorization and control are implemented through the use of a Clearinghouse(s) entity and Secure Container (SC) technology. The Clearinghouse(s) provides licensing authorization by enabling intermediate or End-User(s) to unlock content after verification of a successful completion of a licensing transaction. Secure Containers are used to distribute encrypted content and information among the system components. A SC is a cryptographic carrier of information or content that uses encryption, digital signatures, and digital certificates to provide protection against unauthorized interception or modification of electronic information and content. It also allows for the verification of the authenticity and integrity of the Digital Content. The advantage of these rights management functions is that the electronic Digital Content distribution infrastructure does not have to be secure or trusted. Therefore transmission over network infrastructures such as the Web and Internet. This is due to the fact that the Content is encrypted within Secure Containers and its storage and distribution are separate from the control of its unlocking and use. Only users who have decryption keys can unlock the encrypted Content, and the Clearinghouse(s) releases decryption keys only for authorized and appropriate usage requests. The Clearinghouse(s) will not clear bogus requests

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from unknown or unauthorized parties or requests that do not comply with the content's usage conditions as set by the content proprietors. In addition, if the SC is tampered with during its transmission, the software in the Clearinghouse(s) determines that the Content in a SC is corrupted or falsified and repudiate the transaction". The clearing house will not release decryption key to a device not meeting belonging to an authorized users or to users without appropriate usage conditions.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

6. **Claims 1-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al. U.S. Patent No. 6,226,618 (hereinafter '618).

As to independent claim 10, "An information vending method comprising the steps of" is taught in '618 col. 1, lines 51-56;

"accumulating information for sale" is shown in '618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

“generating usage conditions in response to a purchase selection of the information for sale; encrypting said purchase selection; generating a cryptographic key which decrypts said purchase selection” is disclosed in ‘618 col. 50, line 33 through col. 52, line 32;

“authenticating a recording medium loaded on said information vending apparatus in one of direct and indirect manners; and writing said purchase selection to said recording medium authenticated in the authentication step along with said usage conditions and said cryptographic key” is disclosed in ‘618 col. 6, line 65 through col. 7, line 65 .

As to dependent claim 11, **“further comprising communicating with a reproduction unit for reproducing said purchase selection recorded on said recording medium; wherein in said authentication step, said reproduction unit is further authenticated when in said communication step said reproduction unit is communicated; and in said writing step, said encrypted information for sale along with said usage conditions and said cryptographic key are written to said recording medium through said reproduction unit”** is taught in ‘618 col. 7, line 40 through col. 8, line 5.

As to dependent claim 12, **“wherein said reproduction unit is a portable device and said storage medium is a portable medium, said portable medium being detachably loaded on said portable device”** is shown in ‘618 col. 11, lines 29-53.

As to dependent claim 13, **“wherein in said communication step, said reproduction unit which reproduces said purchase selection recorded on said recording medium integrally disposed on said reproduction unit is communicated; and in said writing step, said encrypted purchase selection along with said usage conditions and said cryptographic**

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key are written to said recording medium integrally disposed on said reproduction unit” is disclosed in ‘618 col. 7, lines 11-65.

As to dependent claim 14, “wherein said reproduction unit is a portable device and said storage medium is fixedly and integrally arranged on said portable device” is taught in ‘618 col. 6, lines 37-48.

As to dependent claim 15, “further comprising: receiving said information for sale supplied through a predetermined transmission path; wherein in said accumulation step, said information received by said receiving means is accumulated” is shown in ‘618 col. 26, line 35 through col. 27 line 18.

As to dependent claim 16, “wherein said transmission path is the Internet, said information is supplied via the Internet to a server unit, and said information is received from said server unit to be stored in said accumulation step” is disclosed in ‘618 col. 26, line 35 through col. 27 line 18.

As to dependent claim 17, “wherein in said usage condition generating step, said usage conditions which are employed by said reproduction unit which reproduces said purchase selection recorded on said recording medium are generated; and in said encryption step, said purchase selection is accessed by use of an algorithm which allows said reproduction unit to decrypt said purchase selection” is taught in ‘618 col. 7, lines 11-55.

As to dependent claim 18, “wherein said information for sale includes at least one of program, voice, music, still picture, moving picture, text data” is shown in ‘618 col. 1, lines 50-57.

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As to independent claim 1, this claim is directed to the apparatus of the method of claim 10 and is rejected along similar rationale.

As to dependent claims 2-9, these claims are substantially similar to claims 11-18 and are rejected along the same rationale.

As to independent claim 19, this claim is directed to a program storage medium of the method of claim 10 and is rejected along similar rationale.

As to independent claim 20, “An information vending apparatus comprising” is taught in ‘618 col. 1, lines 51-56;

“an accumulation unit configured to accumulate information for sale” is shown in ‘618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

“a usage condition generating unit configured to provide usage condition for said information for sale in response to a purchase selection of information for sale; an encryption unit configured to encrypt said purchase selection” is disclosed in ‘618 col. 50, line 33 through col. 52, line 32;

“an encryption key generating unit configured to generate a cryptographic key which decrypts said purchase selection; an authentication unit configured to authenticate a recording medium directly or indirectly loaded on said information vending apparatus; and a writing unit configured to write said purchase selection to said recording medium authenticated by said authentication means along with said usage conditions and said cryptographic key” is disclosed in ‘618 col. 6, line 65 through col. 7, line 65.


Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 6:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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SUPERVISORY PATENT EXAMINER
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Patent Examiner
Technology Center 2134
4 August 2005